

### **REMARKS**

This Amendment is responsive to the Office Action<sup>1</sup> of December 10, 2009. Applicant had filed an appeal brief on September 8, 2009 and prosecution was reopened. Claims 1-7 and 9-18 were appealed and are currently pending.

Claims 1, 9, 11, 16 and 17 are in independent form and each is currently amended. Support for the claim amendments is found in the application as filed; see, for example, Applicant's specification, at least paragraph [0034]. No claims are added or canceled. Claim 8 was previously canceled without prejudice or disclaimer.

Claims 1-7 and 17 are rejected under 35 U.S.C. § 101 because the independent claims allegedly fail to meet the machine or transformation test, and therefore, allegedly fail to satisfy section 101 requirements.

Claims 1-7, 9, 12 and 18 are rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Burnstein et al. (U.S. 2002/0032735 A1; hereinafter "Burnstein") in view of Munsil et al., U.S. Patent 5,761,650 (hereinafter, "Munsil"), and further in view of newly-cited Quach (U.S. 2004/0080534 A1; hereinafter, "Quach").

Claims 11 and 13-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Burnstein in view of Quach.

Claims 10 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Burnstein in view of Munsil in view of Quach and further in view of Carter et al. (U.S. 2005/0068983 A1; hereinafter "Carter").

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<sup>1</sup> The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement.

Claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Munsil.

These rejections are respectfully traversed.

**35 U.S.C. § 101:**

Claims 1-7 and 17 are rejected under 35 U.S.C. § 101 because the claims allegedly fail to meet the machine or transformation test. Without acquiescing in this rejection, Applicant has amended independent method claims 1 and 17 to be reliant upon computer-implementation and has further amended those claims to recite at least one method step in each claim that is performed by operation of the computer. Applicant submits that amended independent claims 1 and 17, and dependent claims 2-7 dependent from claim 1, clearly meet the machine or transformation test and that this rejection is overcome.

**Independent claim 1:**

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach. Claim 1 recites, *inter alia*:

“receiving an inquiry about a community of interest (COI) from *one customer in said portion*; determining existence of said COI with which *other customers in said portion* are associated; sending, by operation of said computer, a generated status message to *only said other customers*, if said COI exists, as confirmation that said one customer has joined said COI;” (emphasis added)

The Office Action admits “Burnstein fails to expressly disclose generating and sending a status message to said certain customers as confirmation that said at least one inquiring customer has joined said COI.” (Office Action, ¶ 14, pg 6) Applicant submits that Burnstein not only fails to expressly disclose that status message, but fails, without qualification, to disclose that status message.

The Examiner then relies upon Quach: "However, Quach discloses generating a message to current members regarding a new member to a community/group (Para 0143-0144, Fig. 13A)." (Office Action, ¶ 15, pg 6) Those Quach paragraphs provide:

[0143] FIG. 19 is a screen shot of an exemplary embodiment user-interface 210 for podium messaging. Using podium messaging, a user can post an instant message for other users. The users for whom the instant message is posted may belong to one or more forums. A podium message is an instant message for all users who are currently browsing the website or are currently logged onto a system incorporating podium messaging. A system administrator may choose to allow whether a non-member can view the podium message. (emphasis added)

[0144] While the podium is not being used, it may issue a default announcement, for example an announcement of the newest member who joined the site last. For example, FIG. 13A illustrates the use of a default announcement "Be a friendly neighbor and help welcome Craigay2000 in 585 area code who joined us recently at . . . " to encourage other members to welcome a new member. Podium messages may be deleted periodically, for example at the end of the day. A Broadcast message is similar to a podium message. However, the life of a broadcast message is preferably longer than that of a podium message. FIG. 19 illustrates a plurality of broadcast messages in the column "Site Broadcast". (emphasis added)

Quach paragraph [0143] says that it uses "podium" messaging which is an "instant message" posted for other users. It says that the podium message is an instant message for all users who are currently browsing the website or are currently logged onto a system incorporating podium messaging (potentially all users can be browsing or logged on). Further, it also says that a system administrator may *choose* to allow *non-members* of the group to view the podium message. Quach paragraph [0144] says that the podium may issue an announcement about the newest member who *joined* the site last. It says: "'Be a friendly neighbor and help welcome....' to encourage other members to welcome a new member" which teaches that the welcoming messages in Quach are posted by other than the newest member. This "Be a friendly neighbor..." announcement is also displayed in Quach in Fig. 13a. Thus, Quach teaches that its welcoming announcement, made by way of its podium messaging technique, not only is directed

to group members, but can also be directed to *non-group members* under a system administrator's discretion. Furthermore, Quach teaches that the welcoming announcement is also directed only from a pre-existing, welcoming, member to potentially all group members which necessarily includes its newest member who joined the site last and is the member being welcomed.

Quite differently, Applicant's claim 1 recites, in part, "receiving an inquiry about a community of interest (COI) from *one customer in said portion*; determining existence of said COI with which *other customers in said portion* are associated; sending, by operation of said computer, a generated status message to only said other customers, if said COI exists, as confirmation that said one customer has joined said COI," (emphasis added) Thus, Applicant's generated status message to the effect that the one customer has joined the COI is sent to only the other customers. Applicant's generated status message is not sent to the one customer from whom inquiry was received and who "has joined said COI" as recited in claim 1.

In sum, Quach teaches that a welcoming member sends an instant message about the newest member who has joined the site last to ALL members which necessarily includes that newest member (not to mention the fact that Quach also sends the message to non-members via the system administrator). Applicant's claim 1 clearly avoids Quach because (1) the claim excludes the newest member from receiving that status message and (2) the claim excludes non-members from receiving that status message while Quach teaches the opposite. Therefore, Quach taken individually or in combination with Burnstein and/or Munsil does not disclose or suggest "sending by operation of said computer a generated status message to only said other customers, if said COI exists, as confirmation that said one customer has joined said COI" as recited in claim 1 because (1) Quach is deficient for reasons given above, (2) Burnstein, as

admitted in the Office Action, does not teach this claim limitation and (3) Munsil was cited merely to show bill inserts in billing statements (Office Action, ¶ 12, pg 5) and does not cure this deficiency in Burnstein or Quach.

Therefore, for reasons given above, the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Dependent claims 2-7 and 18 are likewise allowable, at least for reasons based on their respective dependencies from an allowable base claim.

**Independent claim 9:**

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach. Claim 9 recites, *inter alia*:

“means for sending a generated status message to only said other customers as confirmation that said one customer has joined said COI” (emphasis added)

Claim 9 is allowable for reasons that are the same as, or similar to, those given above for allowance of claim 1 and the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn and the claim allowed.

Dependent claim 10 is also allowable at least for reasons based on its dependency from an allowable base claim.

**Independent claim 11:**

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Quach. Claim 11 recites, *inter alia*:

“wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, and a status message is generated and sent to only said certain customers as confirmation that said at least one inquiring customer has joined said COI” (emphasis added)

Claim 11 is allowable for reasons that are the same as, or similar to, those given above for allowance of claim 1 and the 35 U.S.C. § 103(a) rejection of claim 11 should be withdrawn and the claim allowed.

Dependent claims 12-15 are also allowable, at least for reasons based on their dependencies from an allowable base claim.

**Independent claim 16:**

Claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Muusil. Claim 16 recites, *inter alia*:

“a selection field for allowing said customer to choose a topic of interest, said topic of interest being identified by said customer responding to questions in a customer profile questionnaire presented by said service provider to said customer on said data display and being linked to at least a subset of said persons sharing said common interest with said customer, said selection field including a new group button for (a) creating a new group of persons including said customer and a further subset of said subset of persons, all of whom are interested in an un-displayed topic of interest and (b) allowing a generated status message to be sent to *only* said further subset of said subset of said persons as confirmation that said customer has successfully created said un-displayed topic of interest and has joined said new group (emphasis added)

Claim 16 is allowable for reasons that are the same as, or similar to, those given above for allowance of claim 1. For example, Burnstein, admittedly, (Office Action, ¶ 14, pg 6) does not teach generating and sending a status message to certain customers (persons) as confirmation that the newest customer (person) has joined a community of interests (COI). Therefore, Burnstein does not teach “allowing a generated status message to be sent to only said further subset of said subset of said persons as confirmation that said customer has successfully created said un-displayed topic of interest and has joined said new group” as recited in claim 16 (emphasis added). Muusil is cited to teach messages in billing statements which is irrelevant to the Burnstein deficiency and, in fact, does not cure the Burnstein deficiency. If Quach were

applied in this rejection, which it wasn't, it too, taken individually, or in combination with Burnstein and Munsil would not disclose or suggest this claim limitation because of reasons given above with respect to the deficiency in Quach. Therefore, the 35 U.S.C. § 103(a) rejection of claim 16 should be withdrawn and the claim allowed.

**Independent claim 17:**

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Munsil in view of Quach and further in view of Carter. Claim 17 recites, *inter alia*:

"sending, by operation of said computer, if said COI exists, a generated status message only to others of said subset who belong to said COI as confirmation that said inquiring customer has joined said COI" (emphasis added)

Carter is cited merely to teach "randomly generating alias identity information for community users (Para 0039)." (Office Action, ¶ 37, pg. 10) Carter is not relevant to, and does not teach, the deficiency of the combination of Burnstein, Munsil and Quach relative to the recited claim limitation. Thus, Carter does not cure that deficiency. Therefore, claim 17 is allowable over Burnstein, Munsil, Quach and Carter taken individually or in any reasonable combination for reasons that are the same as, or similar to, those reasons given above for allowability of claim 1.

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Although Applicant has again focused above on certain limitations that relate to a status message, Applicant does not acquiesce in the rejections presented in the Office Action for other reasons. For example, Applicant believes that Burnstein also fails as an effective teaching reference with respect to Applicant's recited subject matter because it does not provide a plurality of customer with "a customer profile questionnaire" as recited, for example, in claim 1.

**Burnstein's providing a search ability is not equivalent to Applicant's sending a questionnaire and Burnstein's inputting search strings is not equivalent to Applicant's completing and submitting the questionnaire.**

Applicant respectfully disagrees with the Examiner's position as expressed, for example, on page 4 of the Office Action. Therein, when referring to Burnstein, Figs. 6-10, it says "*Figs. 6-10, providing search ability and receiving search string information is equivalent to sending a questionnaire and receiving responses - in both cases data is receive [sic] to correlate users; The invention disclosed by Burnstein is meant to be an advancement on collecting profile information through a simple questionnaire, Para 0114; Burnstein discloses establishing matches based on search string information, identification information and other derived profile type information, Para 0028;*" (Office Action, ¶ 10, pg 4, emphasis in original) Burnstein may receive data by operation of its technique, but Burnstein is not equivalent to a questionnaire. In certain respects Burnstein's technique is not as effective as the "simple questionnaire."

Receiving data (the subject to be searched) to correlate users because Burnstein's receiver of that data (the search service/engine) wants to correlate users is not equivalent to receiving data to correlate users because Applicant's supplier of that data wants to correlate users. Burnstein says: "After making a match the invention automatically invites the matched parties to join a frictionless and immediate electronic community if they so desire." (Burnstein, paragraph 13) Thus, a received search string in Burnstein carries with it a question about whether it is acceptable subject matter for discussion within the electronic community but, quite differently, information supplied in response to Applicant's questionnaire is pre-approved by the supplier for community discussion because that is why it is being supplied in the first place.



In other words, in Burnstein, after a search request is made, the searching party receives, and possibly is surprised or even annoyed, with an invitation to join a group whose members have also searched the same topic. The searching party may refuse. Not every subject is a candidate for discussion for every searching party. Some subjects may be very private/sensitive to some individuals under certain circumstances. This is quite different from receiving a questionnaire, as Applicant discusses, to be voluntarily answered by a party who knows in advance that he/she is attempting to join a discussion group about a subject(s) of interest and who wants to discuss that subject. Common data does not necessarily imply a mutual interest in the parties submitting that common data to discuss it. That is why Burnstein offers the option of not joining a COI: i.e., "if they so desire" as noted above. However, Applicant's questionnaire, which is to be affirmatively completed only if the participant wants to participate in a discussion of a particular subject noted in the questionnaire, is quite different, *ah initio*, from a search request. Thus, contrary to the Examiner's interpretation, Burnstein's teaching of search ability is not equivalent to Applicant's teaching of sending a questionnaire and Burnstein's teaching of receiving search string information is not equivalent to Applicant's teaching of responding to the questionnaire.

**Burnstein's search string shall not express a range of interests equivalent to those which can be expressed in a response to a questionnaire designed to elicit, *inter alia*, subjects of interest appropriate for community discussion.**

Considering Burnstein from a different perspective, its search string teaching again lacks equivalence to Applicant's questionnaire response. Applicant submits that people ordinarily do not search all subjects in which they have interest. A search of a particular subject is conducted for a particular reason and a search string is focused on a specific topic. Therefore a large

segment of subject matter of interest to an individual, if not searched, shall remain undisclosed to the Burnstein search and automatic community formation technique. But, in accordance with the teachings of Burnstein, it uses no more than that individual's search string as the basis for inquiring about his/her interest in joining a community of interest (COI). That search string is merely a subset of subject matter of interest to that individual.

By contrast, when presenting a questionnaire, in accordance with Applicant's disclosure, a wide-ranging and open ended inquiry about subject matter of interest can be presented to that individual who is not restricted in his/her response. Thus, subjects in a wide spectrum, and unrelated to each other, can emerge responsive to a questionnaire presented to that individual, as compared to that individual's submitting a mere subset of those subjects, if not only one subject, for a search. Accordingly, Applicant can offer a basis for chatting with others on virtually all non-private subjects of current interest to that individual while Burnstein does not. This example underscores the fact that the search string information and the questionnaire responses are not equivalent mechanisms for setting up communities of interest for conversation or interaction.

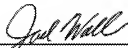
Therefore, in addition to the status message argument given above for allowability of the claims, which is independent of this instant questionnaire discussion, Applicant continues to contend that Burnstein is not an effective reference because a questionnaire is not disclosed or suggested in Burnstein in the first place. The searching technique disclosed in Burnstein, although possibly represented by Burnstein as an advancement over a questionnaire, is not, in fact, a questionnaire and is not equivalent to a questionnaire. Therefore, the pending claims are allowable for this reason as well.

**CONCLUSION**

All rejections in the Office Action have been addressed. In view of the foregoing remarks, reconsideration and allowance of the pending claims are respectfully requested.<sup>2</sup>

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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<sup>2</sup> Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.